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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,438	12/30/2003	Alan G. McNaughton	46824-9	4349
26123 7590 01/11/2007 BORDEN LADNER GERVAIS LLP WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100 OTTAWA, ON K1P 1J9 CANADA			EXAMINER CHARLES, DEBRA F	
			ART UNIT 3691	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/019,438	Applicant(s) MCNAUGHTON ET AL.	
	Examiner Debra F. Charles	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/2/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Objections***

1. Preliminary amended claims need to be on a separate page.
2. Numbering: amended claims must be numbered starting from the previously cancelled claims. Claims 1- 20 were cancelled. New claims must start with number 21 and not number 1. Examiner has renumbered the claims accordingly.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbox(US 5705798 A) and Call et al.(US 4012720A).

Re claims 21, 22, 23,29,30, 33: Tarbox disclose a dynamically branded transaction execution system(Abstract, Col. 2, lines 55-col. 3, line 35) consisting of

- a) at least two selected institutions(col. 4, lines 10-50);

b) at least one shared transaction execution device for accessing the selected institutions(col. 4, lines 15 – 50);

c) a processing and routing system for operatively coupling the selected institutions to the device(col. 3, lines 55-65).

Tarbox fail to teach a macro identity including identification information for configuring the transaction execution device to enable the interaction of at least one of the selected institutions with the customer through the device; wherein the customer uses the macro identity for conducting a transaction session between a plurality of customer accounts provided by at least one of the selected institutions. However, Call et al. does teach an identity code 170 for the terminal or matrix board 104, an identity code for the particular Brand A, such as preferably recorded in binary coded decimal (BCD), represented by code positions 172 through 178, and a product category identify code, such as represented by the two code positions 180 and 182, which code is preferably also in BCD. In addition, as will be described in greater detail hereinafter with reference to FIG. 7, lock out holes 184 and 186 are also preferably provided which holes 184, 186, must be properly aligned before the terminal or primary data entry source 102 is operable.

Such proper alignment is preferably indicated by the lighting of signal lamp 116 which alerts the operator that the card 118 has been properly installed. Since the card edge reader 114 can preferably distinguish different overlay mask cards 118 by means of optically reading the associated identity codes 172 and 182, the given crosspoint locations on the matrix array board 104 can be defined differently with different overlay masks in the associated computer program which conveniently analyzes this data. In this manner, the matrix array board 104 provides a generalized data input device that can be utilized for a wide variety of input purposes. Thus, for example, a given crosspoint location on the matrix array board 104 could indicate chocolate flavor if a particular overlay mask 118 was removably installed or inserted in the card edge reader 114 or the same crosspoint location might indicate liquid as opposed to solid if a different overlay mask 118 were removably installed or inserted in the card edge reader. Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Tarbox to include the step of Call et al. The motivation to combine these references is to show that credit card branding can be applied to ATM machine transactions relevant to banks and other financial institutions that do transactions.

Re claims 24 and 31: Tarbox disclose wherein the device operatively connects to the accounts of two customers maintained by at least one of selected institutions for executing the transaction session between the accounts of the two customers(col. 3, lines 1-30).

Re claim 25: Tarbox disclose wherein the macro identity includes account information for a plurality of the accounts at a plurality of the selected institutions(col. 3, lines 40-67).

Re claim 26: Tarbox disclose wherein the macro identity is registered by the system when the customer initiates the transaction session with the device(Fig. 1-3).

Re claim 27: Tarbox disclose wherein the transaction session is initiated when the customer selects the macro identity function from a wait state of the device(Fig. 5, 6A-6F).

Re claim 28: Tarbox disclose a smart-card, a portable device, a storage device maintained and operated by the customer, the shared transaction execution device, the routing and switching component of the system, and at least one of the selected institutions(col. 2, lines 10-35).

Re claim 32. Tarbox disclose wherein customer information about prior transaction sessions is used to predictively personalize said transaction session upon identification of the customer using the macro identity(col. 3, lines 1-35).

Re claim 34: Tarbox disclose d) a revenue stream generated as a result of said transaction session between said user and the device(col. 10, lines 5-40).

Re claim 35: Tarbox disclose said user upon starting the transaction session is provided with a first choice to emulate one or more of said user's prior choices from a group of available prior choices selected from the group comprising: accounts, institutions, transactions, and

connections of said user's last or most frequent or most relevant prior transaction sessions(col. 9, line 55-col. 10, line 15).

Re claim 36: Tarbox disclose wherein the first choice is given to said user prior to a second choice comprising a broader choice of institutional accounts and transactions if said first choice is declined by said user(Fig. 2-5, col. 8, lines 5-40).

Re claim 37: Tarbox disclose wherein said first choice is responsive to predetermined criteria(Fig. 2, col. 5, lines 45-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (571) 272 6791. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Debra F. Charles  
Examiner  
Art Unit 3691

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HANI M. KAZIMI  
PRIMARY EXAMINER